



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/282,893	03/31/1999	DARYL C. CROMER	RP9-99-005	9241

25299 7590 10/01/2002

IBM CORPORATION
PO BOX 12195
DEPT 9CCA, BLDG 002
RESEARCH TRIANGLE PARK, NC 27709

EXAMINER

MOORE, JAMES K

ART UNIT PAPER NUMBER

2682

DATE MAILED: 10/01/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/282,893

Applicant(s)

CROMER ET AL.

Examiner

James K Moore

Art Unit

2682

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 July 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-17 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-17 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The limitation "utilizing a preset calling function at preset intervals to identify a potential theft when the position has not violated the boundary conditions" was not described in the specification. The passage in the specification that was alleged by the applicant as describing this limitation (page 8, lines 12-22) states that the portable computer periodically reports its identification and its location, but does not describe how a potential theft may be identified when the portable computer has not violated the boundary conditions.

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. **Claims 1, 2, and 5-17** are rejected under 35 U.S.C. 103(a) as being unpatentable over Hertel (U.S. Patent No. 5,532,690) in view of Klein (U.S. Patent No. 5,936,526).

Regarding **claim 1**, Hertel teaches a method for providing protection against theft and loss of a vehicle. The method comprises: establishing boundary conditions within which the vehicle is authorized for use; tracking a position of the vehicle with a GPS unit in the vehicle; comparing the position to the boundary conditions to identify whether the vehicle has violated the boundary conditions; and performing anti-theft routines when the position has violated the boundary conditions. See Abstract. Hertel does not disclose that the method is used in a portable computer system. However, Klein discusses the problem of portable computer theft and the need to provide protection against it. See Background. It would have been obvious to one of ordinary skill in the art at the time of the invention to use Hertel's method with a portable computer system, in order to prevent its theft.

Regarding **claim 2**, Hertel in view of Klein teaches all of the limitations of **claim 1**. Klein also teaches an anti-theft routine that comprises calling a preset phone number with a cellular calling facility of a portable computer system. See col. 6, lines 60-66. It would have been obvious to one of ordinary skill in the art at the time of the invention to

further modify Hertel with Klein, such that the anti-theft routines comprise calling a preset phone number with a cellular calling facility of a portable computer system, so that the owner is notified of the theft.

Regarding **claim 5**, Hertel in view of Klein teaches all of the limitations of **claim 1**. Hertel's tracking also inherently comprises reporting the position of the portable computer system at preset intervals.

Regarding **claim 6**, Hertel teaches a method for providing protection against theft and loss of a vehicle. The method comprises: utilizing GPS functionality within a vehicle to track a position of the vehicle; identifying when the position tracked by the GPS functionality violates preset boundary conditions of the vehicle; and utilizing cellular calling functionality within the vehicle to report a potential theft of the vehicle when the preset boundary conditions have been violated. See col. 5, lines 15-51. Hertel does not disclose that the method is used in a portable computer system. However, Klein discusses the problem of portable computer theft and the need to provide protection against it. See Background. It would have been obvious to one of ordinary skill in the art at the time of the invention to use Hertel's method with a portable computer system, in order to prevent its theft.

Regarding **claim 7**, Hertel in view of Klein teaches all of the limitations of **claim 6**. Hertel also discloses that the method comprises establishing the preset boundary conditions as a chosen distance from a given location within which use of the vehicle is allowed. See col. 4, line 66 through col. 4, line 7.

Regarding **claim 8**, Hertel in view of Isikoff teaches all of the limitations of **claim 6**. Klein also teaches an anti-theft routine that comprises calling a preset emergency phone number by utilizing the cellular calling functionality of a portable computer system. See col. 6, lines 60-66. It would have been obvious to one of ordinary skill in the art at the time of the invention to further modify Hertel with Klein, such that the portable computer system calls a preset emergency phone number, so that the owner is notified of the theft.

Regarding **claim 9**, Hertel in view of Klein teaches all of the limitations of **claim 8**. Klein also teaches sending a location of the portable computer system to the preset emergency phone number. See col. 6, lines 60-66.

Regarding **claim 10**, Hertel in view of Klein teaches all of the limitations of **claim 9**, but does not teach that the location is sent as a data stream using facsimile protocol. However, the examiner takes Official notice that a facsimile protocol is a well known protocol for transmitting data across a wireless interface, and also that many portable computers are manufactured with the capability of transmitting facsimile information. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to further modify Hertel in view of Klein, such that the location is sent as a data stream using facsimile protocol, in order to utilize a portable computer system's built-in communication capabilities and thereby avoid extra expenses.

Regarding **claim 11**, Hertel in view of Klein teaches all of the limitations of **claim 6**. Hertel also inherently utilizes the GPS functionality at regularly scheduled predetermined intervals.

Regarding **claim 12**, Hertel in view of Klein teaches all of the limitations of **claim 6**. Furthermore, in using Hertel's method to provide protection against theft of a portable computer system, one of ordinary skill in the art would realize that the GPS functionality can be utilized at all times, including during booting upon power-up of the portable computer system.

Regarding **claim 13**, Hertel teaches a communication control system for providing built-in anti-theft capabilities in a vehicle. The communication control system comprises: a controller (30); a GPS unit (14) coupled to the controller for tracking a position of the vehicle; and a storage unit (16). The storage unit is coupled to the controller and stores preset boundary conditions and out-of-boundary actions. The controller compares the position to the boundary conditions and initiates the out-of-boundary actions when the comparison identifies a violation of the boundary conditions. See Abstract and Figure 1. Hertel does not disclose that the communication control system is used in a portable computer system. However, Klein discusses the problem of portable computer theft and the need to provide protection against it. See Background. It would have been obvious to one of ordinary skill in the art at the time of the invention to use Hertel's communication control system with a portable computer system, in order to prevent its theft.

Regarding **claim 14**, Hertel in view of Klein teaches all of the limitations of **claim 13**. Klein also teaches a portable computer system comprising a cellular unit for calling a preset phone number as an anti-theft routine. See col. 6, lines 60-66. It would have been obvious to one of ordinary skill in the art at the time of the invention to further

Art Unit: 2682

modify Hertel with Klein, such that the portable computer system comprises a cellular unit for calling a preset phone number as an out-of-boundary action, so that the owner is notified of the theft.

Regarding **claim 15**, Hertel in view of Klein teaches all of the limitations of **claim 14**. Klein also teaches that the cellular unit reports a location of the portable computer system. See col. 6, lines 60-66.

Regarding **claim 16**, Hertel in view of Klein teaches all of the limitations of **claim 13**. Hertel's GPS unit also inherently tracks the position at preset intervals.

Regarding **claim 17**, Hertel in view of Klein teaches all of the limitations of **claim 13**. Hertel also discloses that the storage unit stores a predetermined distance from a central location as an in-bounds condition for the vehicle. See col. 4, line 66 through col. 4, line 7.

6. **Claims 3 and 4** are rejected under 35 U.S.C. 103(a) as being unpatentable over Hertel in view of Klein as applied to **claim 1** above, and further in view of Isikoff (U.S. Patent No. 5,748,084).

Regarding **claims 3 and 4**, Hertel in view of Klein teaches all of the limitations of **claim 1**, but does not teach that the anti-theft routines comprise prompting a user for a password, wherein operation of a portable computer system continues uninterrupted when the password matches a master password and operation of the portable computer system is disabled when the password does not match the master password. However, Isikoff teaches an anti-theft routine for a portable computer system that comprises

Art Unit: 2682

prompting a user for a password, wherein operation of a portable computer system continues uninterrupted when the password matches a master password and operation of the portable computer system is disabled when the password does not match the master password. See col. 4, lines 39-61. It would have been obvious to one of ordinary skill in the art at the time of the invention to further modify Hertel in view of Klein with Isikoff, such that the anti-theft routines comprise prompting a user for a password, wherein operation of a portable computer system continues uninterrupted when the password matches a master password and operation of the portable computer system is disabled when the password does not match the master password, so that the anti-theft routines may be overridden by an authorized user.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 2682

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ken Moore, whose telephone number is (703) 308-6042. The examiner can normally be reached on Monday-Friday from 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivian Chin, can be reached at (703) 308-6739.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 872-9314 (for Technology Center 2600 only)

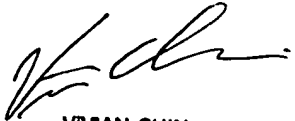
Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

Ken Moore

9/23/02

JKM


VIVIAN CHIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600